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09/904,395	07/12/2001	Thomas J. Foth	F-262	1974

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EXAMINER

ABRISHAMKAR, KAVEH

ART UNIT PAPER NUMBER

2131

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/904,395	<b>Applicant(s)</b> FOTH, THOMAS J.	
	<b>Examiner</b> Kaveh Abrishamkar	<b>Art Unit</b> 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 32-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 32-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. This action is in response to the response to the election/restriction requirement, received March 7, 2005. Claims 1-48 were originally received for consideration. Per the received response to the election/restriction requirement, claims 1-19 and 32-48 remain pending in the application.

#### ***Election/Restrictions***

2. Applicant's election without traverse of claims 1-19 and 32-48 in the reply filed on March 7, 2005 is acknowledged.

#### ***Information Disclosure Statement***

3. Initialed and dated copies of the Applicant's IDS 1449 forms, received 7/12/2001, 8/13/2002, 9/19/2002, 10/15/2002, 2/20/2003, 6/20/2003, 3/22/2004, 10/04/2004, and 3/07/2004, are attached to this Office action.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-10, 13-19, 32-33, and 37-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamauchi (U.S. Patent No. 6,819,917).

Regarding claim 1, Yamauchi discloses:

A system for remotely retrieving a document comprising:

a facsimile machine coupled to a telephone network (Figure 1 item 150);

an adaptor coupled between said telephone network and said facsimile machine (Figure 1 item 20); and

a mobile device (Figure 1 item 10), said mobile device communicating with said adaptor and causing said adaptor to retrieve said document via said telephone network, said adaptor providing said document to said facsimile machine for printing (column 4 lines 7-11).

Claim 2 is rejected as applied above in rejecting claim 1. Furthermore, Yamauchi discloses:

The system according to claim 1, further comprising: a data center to store said document (Figure 1 item 30), said data center being coupled to said telephone network (Figure 1 item 40).

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Claim 3 is rejected as applied above in rejecting claim 2. Furthermore, Yamauchi discloses:

The system according to claim 2, wherein said document is selected from a plurality of documents stored in said data center (column 6 lines 44-56, column 6 lines 20-30).

Claim 4 is rejected as applied above in rejecting claim 2. Furthermore, Yamauchi discloses:

The system according to claim 2, wherein said adaptor is further configured to receive a document from said mobile device via said communication between said mobile device and said adaptor and send said received document to said data center (column 6 lines 44-56, column 6 lines 20-30).

Claim 5 is rejected as applied above in rejecting claim 1. Furthermore, Yamauchi discloses:

The system according to claim 1, wherein said mobile device communicates with said adaptor via a hard-wired communication (column 4 lines 34-42).

Claim 6 is rejected as applied above in rejecting claim 1. Furthermore, Yamauchi discloses:

The system according to claim 1, wherein said mobile device communicates with said adaptor via a wireless communication (column 4 lines 23-34).

Claim 7 is rejected as applied above in rejecting claim 6. Furthermore, Yamauchi discloses:

The system according to claim 6, wherein said wireless communication is an infrared communication (column 4 lines 23-34).

Claim 8 is rejected as applied above in rejecting claim 6. Furthermore, Yamauchi discloses:

The system according to claim 6, wherein said wireless communication is a radio frequency communication (column 4 lines 23-34).

Claim 9 is rejected as applied above in rejecting claim 6. Furthermore, Yamauchi discloses:

The system according to claim 6, wherein said wireless communication is automatically established (column 4 lines 23-34).

Claim 10 is rejected as applied above in rejecting claim 6. Furthermore, Yamauchi discloses:

The system according to claim 6, wherein said wireless communication includes inductive coupling (column 4 lines 23-34).

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Claim 13 is rejected as applied above in rejecting claim 1. Furthermore, Yamauchi discloses:

The system according to claim 1, wherein said mobile device is a personal data assistant (column 4 lines 15-22).

Claim 14 is rejected as applied above in rejecting claim 1. Furthermore, Yamauchi discloses:

The system according to claim 1, wherein said mobile device is a pager (column 4 lines 15-22).

Claim 15 is rejected as applied above in rejecting claim 1. Furthermore, Yamauchi discloses:

The system according to claim 1, wherein said mobile device is a laptop computer (column 4 lines 15-22).

Claim 16 is rejected as applied above in rejecting claim 1. Furthermore, Yamauchi discloses:

The system according to claim 1, wherein said mobile device is a cell phone (column 4 lines 15-22).

Claim 17 is rejected as applied above in rejecting claim 1. Furthermore, Yamauchi discloses:

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The system according to claim 1, wherein said adaptor is a portable device (column 4 lines 15-22).

Claim 18 is rejected as applied above in rejecting claim 1. Furthermore, Yamauchi discloses:

The system according to claim 1, wherein said adaptor is integral to said facsimile machine (column 4 lines 15-23).

Claim 19 is rejected as applied above in rejecting claim 1. Furthermore, Yamauchi discloses:

The system according to claim 1, wherein said adaptor is further configured to receive a document from said mobile device via said communication between said mobile device and said adaptor and send said received document to said facsimile machine for printing (column 4 lines 43-58, column 4 lines 27-33).

Regarding claim 32, Yamauchi discloses:

A method for remotely retrieving and printing a selected document stored in a data center, said data center being coupled to a telephone network, said method comprising the steps of:

coupling a adaptor to said telephone network between said data center and a facsimile machine (Figure 1 item 20,30,40,50);



establishing a communication between a mobile device and said data center via said adaptor and said telephone network (column 3 lines 61-64);

selecting a document stored in said data center using said mobile device (column 3 lines 61-64, column 6 lines 44-56, column 6 lines 20-30);

sending said selected document to said facsimile machine through said adaptor column 3 lines 61-64, column 6 lines 20-56); and

printing said selected document at said facsimile machine (column 4 lines 7-11).

Claim 33 is rejected as applied above in rejecting claim 32. Furthermore, Yamauchi discloses:

The method according to claim 32, wherein said step of selecting a document further comprises:

selecting a document from a plurality of documents stored in said data center (column 6 lines 20-30).

Claim 37 is rejected as applied above in rejecting claim 32. Furthermore, Yamauchi discloses:

The method according to claim 32, wherein said step of establishing a communication further comprises:

establishing a hard-wired communication between said adaptor and said mobile device (column 4 lines 34-42).

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Claim 38 is rejected as applied above in rejecting claim 32. Furthermore, Yamauchi discloses:

The method according to claim 32, wherein said step of establishing a communication further comprises:

establishing a wireless communication between said adaptor and said mobile device (column 4 lines 23-34).

Claim 39 is rejected as applied above in rejecting claim 38. Furthermore, Yamauchi discloses:

The method according to claim 38, wherein said wireless communication is an infrared communication (column 4 lines 23-34).

Claim 40 is rejected as applied above in rejecting claim 38. Furthermore, Yamauchi discloses:

The method according to claim 38, wherein said wireless communication is a radio frequency communication (column 4 lines 23-34).

Claim 41 is rejected as applied above in rejecting claim 38. Furthermore, Yamauchi discloses:

The method according to claim 38, wherein said wireless communication is established automatically (column 4 lines 23-34).

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Claim 42 is rejected as applied above in rejecting claim 38. Furthermore, Yamauchi discloses:

The method according to claim 38, wherein said wireless communication includes inductive coupling (column 4 lines 23-34).

Claim 43 is rejected as applied above in rejecting claim 32. Furthermore, Yamauchi discloses:

The method according to claim 32, wherein said step of selecting a document further comprises:

retrieving a header for each of a plurality of documents stored in said data center (column 27-35); and

selecting said document from said plurality of documents (column 27-35).

Claim 44 is rejected as applied above in rejecting claim 32. Furthermore, Yamauchi discloses:

The method according to claim 32, wherein said adaptor is a portable device (column 4 lines 15-22).

Claim 45 is rejected as applied above in rejecting claim 32. Furthermore, Yamauchi discloses:

The method according to claim 32, wherein said mobile device is a personal data assistant (column 4 lines 15-22).

Claim 46 is rejected as applied above in rejecting claim 32. Furthermore, Yamauchi discloses:

The method according to claim 32, wherein said mobile device is a pager (column 4 lines 15-22).

Claim 47 is rejected as applied above in rejecting claim 32. Furthermore, Yamauchi discloses:

The method according to claim 32, wherein said mobile device is a laptop computer (column 4 lines 15-22).

Claim 48 is rejected as applied above in rejecting claim 32. Furthermore, Yamauchi discloses:

The method according to claim 32, wherein said mobile device is a cell phone (column 4 lines 15-22).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11-12, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi (U.S. Patent No. 6,819,917) in view of McGraw (European Patent Application EP 1,045,574).

Claim 11 is rejected as applied above in rejecting claim 1. Yamauchi does not explicitly disclose encrypting the document prior to being retrieved by the adaptor and the decrypting of the document by the adaptor before it is sent to the facsimile machine. Murphy discloses a system wherein an encrypted FAX is sent to a receiving party, and then is decrypted when the receiving party receives a decode code from the sender (Abstract). The function of the encryption can be done at the computer (adaptor) in the system of Yamauchi, as it was well-known in the art to encrypt information at a device (workstation) at the time of invention. Murphy states, "having sensitive information viewed by unintended viewers could result in a tremendous negative impact on an individual or corporation" (paragraph 2). Murphy encrypts the FAX documents in order to avoid having sensitive FAX documents being viewed by unintended viewers. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to encrypt the FAX documents, as disclosed in Murphy, in the system of Yamauchi in order to avoid "having sensitive information viewed by unintended viewers."

Claim 12 is rejected as applied above in rejecting claim 11. Yamauchi does not explicitly disclose that the adaptor decrypts the encrypted document with a key provided

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by the mobile device. Murphy disclose sending an encrypted document to a receiver which can be decrypted after the requester of the FAX document (the sender of the fax document) provides a decode code (key) (Abstract). The function of the encryption can be done at the computer (adaptor) in the system of Yamauchi, as it was well-known in the art to encrypt information at a device (workstation) at the time of invention. Murphy states, "having sensitive information viewed by unintended viewers could result in a tremendous negative impact on an individual or corporation" (paragraph 2). Murphy encrypts the FAX documents in order to avoid having sensitive FAX documents being viewed by unintended viewers. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to encrypt the FAX documents, as disclosed in Murphy, in the system of Yamauchi in order to avoid "having sensitive information viewed by unintended viewers."

6. Claims 34-36 are method claims analogous to the system claims 11-12 rejected above and therefore, are rejected following the same rationale used above.


**Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaveh Abrishamkar whose telephone number is 571-272-3786. The examiner can normally be reached on Monday thru Friday 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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